

REMARKS

Reconsideration and allowance of the Application are respectfully requested. The following arguments and remarks address the various objections and rejections stated in the above-identified Official Action.

1. The withdrawal of the Restriction Requirement is appreciatively acknowledged. Claims 1 through 45, being all of the Claims originally filed, were addressed in the Official Action and are treated herein.

2. The Specification requirements concerning the ABSTRACT are dully noted.

3. The ABSTRACT has been corrected herein as suggested in the Official Action.

4. The objection to Claim 21 has been addressed by entering the suggested amendment, and it is requested that the objection be withdrawn.

5. The rejection of Claims 21 and 28 under 35 U.S.C. 102 (b) as anticipated by Hey (US 5,908,264) is respectfully traversed. It is axiomatic that for a reference to anticipate a Claim it is necessary that the reference teach each and every element of the rejected Claim. In this situation Hey fails to teach every element of the rejected Claims.

With regard to Claim 21, the Examiner has characterized “a height adjustment actuator/sleeve with a pin (36) accessible along an associated boatlift leg...”, with specific reference to Fig 1: col. 3, lines 53-67 and col. 4, lines 1-42. These descriptive matters have been considered, and do not support the characterization of the Examiner that a “height adjustment actuator” is taught or suggested. While it may be conceded that Hey teaches a mechanism by which height can be adjusted, it in no way teaches any form of “actuator” mechanism as is taught and claimed by Applicants. The Hey leg 38 slides within housing 36, wherein each leg and its associated housing have a number of spaced-apart mating holes for receiving a pin, or some such device, to hold the leg at a selected position within the housing. As shown and taught by Hey, the actual movement of the leg within the housing must be accomplished by an external motive force to align the holes, there being no height adjustment actuator mechanism shown. There is no “height adjustment actuator” as claimed by Applicant’s. Since no actuator is taught by Hey, it

follows that Hey does not teach a relationship of an actuator coupled “at a predetermined angle with respect to said alignment”, as is claimed. It appears, therefore, that the rejection is based upon an error of finding of fact with respect to the teaching of Hey. Since Hey does not teach each element of the Claim, the rejection is an improper legal conclusion, and should be withdrawn.

With regard to Claim 28, the Hey reference also fails to teach each of the means limitations set forth therein. Attention is directed to Fig. 2 and Fig. 2A of the Application, and the descriptive material in the Specification pertaining thereto, for a description of one embodiment of the “height adjustment means” and the “height adjustment actuator means”, as claimed. Hey fails to teach a “height adjustment means for linearly altering the spacing of the footpad means with respect to the end of an associated boatlift leg” or a “height adjustment actuator means for selectively activating said height adjustment means”. The height adjustment sliding leg taught by Hey is incremental and not linear as claimed, and no height adjustment actuator means is taught.

Having explained the differences between the cited art and the Claim limitations, and having pointed out the differences in structure and operation, attention is directed to the examination requirements established by *In re Donaldson Co., Inc.*, 29 USPQ 2nd 1845 (CAFC 1994), where the Court addressed the proper interpretation of 35 U.S.C. 112, 6th paragraph, which deals with means-plus-function claims. *Donaldson* states that –

“The plain and unambiguous meaning of paragraph 6 is that one construing means-plus-function language in a claim must look to the specification and interpret the language in light of corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” (Page 1848)

It is of course apparent that the means-plus-function claim format necessitates giving the functional statements their proper consideration in establishing the inventive concepts of the various means. Failure to address the functional limitations as elements of novelty would render such interpretation improper.

The requirement of examining means limitations includes the necessity of determining the scope of such limitations, and requires interpretation of the claim structure in light of the specification and drawings. This ultimately requires a determination of whether or not the art under consideration teaches structure(s) similar to

or the equivalent of the means limitation(s). It appears that this has not been done. It is submitted that the Hey structure and teaching is neither similar to, nor is it equivalent of the Claim limitations.

It appears that the rejection of Claim 28 has failed to properly apply the requirements of *Donaldson* and is based upon an error of finding of fact with respect to the teaching of Hey, resulting in an improper legal conclusion.

Claims 21 and 28 are neither taught nor suggested by Hey and are allowable as presently presented.

7. The rejection of Claim 38 under 35 U.S.C. 102(b) as anticipated by Holmgren (US 5,655,850) is respectfully traversed. Claim 38 is in the means-plus-function format and requires the same type of examination treatment as set forth above. This has apparently not been done.

The reference to the preamble of the Claim is understood, it having been provided merely to establish an environment and frame of reference for the claimed structure. This of course could be deleted or altered, but it is not deemed necessary to do so. Should the Examiner have a specific objection or requirement in this regard, it would be given careful consideration.

While it is not disputed that Holmgren describes the use of a ball screw structure to raise and lower the lift, though it functions in a manner different from that of claimed structure, that is the total extent of teaching relevant to consideration of allowability of Claim 38.

The Examiner apparently recognizes that Holmgren does not specifically teach switch means, but finds some form of switch "inherent" in Holmgren's direction control. Apparently, this conclusion was derived for col. 4, lines 52 -55, where it is stated,

"Normally, rotatable threaded member 86 is powered by gear motor 80 which rotates rotatable threaded member 86 in one direction to lower the boat and boat lift, and the opposite direction to raise the boat and boat lift."

Even assuming that such an inherency finding is proper, which is challenged, the conclusion is improper. There being no specific teaching in Holmgren, it is not understood how this non-teaching can be judged against the "switch means" recited in

Claim 38, as is required by *Donaldson*. As stated above, it is necessary that there be a proper fact finding that whatever is deemed to be inherent is the equivalent of the structure described by Applicants. This has not been done.

The finding of the Examiner that the "logic means" is taught by the description at col. 4, lines 27-55, is not understood. While it may be that there is some description of the up and down movement in the material cited, it is totally devoid of any teaching of any logic circuitry that will accomplish such functions. Again, this finding of fact is erroneous, and does not comply with the requirements of *Donaldson*, as discussed above.

In summary, the findings of fact utilized to reach the conclusion of law that Claim 38 is anticipated by Holmgren, are erroneous and do not comply with governing law. As such, the rejection is improper and should be withdrawn. It is submitted that Claim 38 is neither taught nor suggested by Holmgren, and is allowable as presently presented.

8. The provisions of 35 U.S.C. 103(a) are duly noted.

9. The rejection of Claims 1, 2 and 16 under 35 U.S.C. 103(a) based upon McLaughlin et al. (US 6,230,639) in view of Holmgren, is respectfully traversed:

McLaughlin et al. teaches a drive mechanism that utilizes motor 51 to drive unit 55 to cause shaft 52 to rotate in one of two possible directions. Four cables 40, 42, 44, and 46 are caused to be wound off or wound on their respective source spools, depending upon the direction of rotation of shaft 52, as particularly illustrated in Fig. 4. As recognized above, Holmgren teaches the use of a ball screw mechanism to pull or to play out lift cables 31, 32, 33, and 34. There is no teaching or suggestion in either reference of a brake mechanism.

Attention is directed to MPEP Section 2143 where the requirements for making a *Prima Facie* case of obviousness are set forth. In summary, it is necessary that the Examiner establish (i) a suggestion or motivation to make the suggested combination or substitution, from within the references or from general knowledge; (ii) a reasonable likelihood of success; and (iii) that the references when combined teach or suggest all of the claim limitations.

The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438. (Fed. Cir. 1991).

In the first instance, there has been no attempt to show any suggestion or motivation to make the substitution suggested by the Examiner. No such motivation is found within either of the references. In point of fact, if the substitution was obvious and motivated, McLaughlin et al. could have included Holmgren in its structure at the outset, since Holmgren issued and was available as teaching prior to the filing of McLaughlin et al.

In the second instance, the likelihood of success of any such combination was not addressed by the Examiner. Since there is a differing cable structure between the two references, it is not clear that the ball screw assembly of Holmgren would in fact have sufficient travel to work within the MaLaughlin et al. structure. In any event, it does not appear that success can be assumed without consideration.

In the third instance, even if combined, the references do not address all of the limitations of Claim 16, in that no brake mechanism is taught. It is insufficient to say that a "brake mechanism" would have been obvious to one skilled in the art. A "brake mechanism" for the drive system of McLaughlin et al. would quite likely be different from a "brake mechanism" that would work with Holmgren. It is submitted that it is improper to make such a finding of fact, without determining that such a "conventional brake system" is in fact available.

In view of the foregoing, it is submitted that the rejection based upon McLaughlin et al. and Holmgren fails to establish a *prima facie* case of obviousness, and is an insufficient basis to reject the claims. Further, it appears that the combination of references was prompted only after viewing Applicants' disclosure, and amounts to an improper rejection based upon a hindsight determination.

It is submitted that the rejection of Claims 1, 2, and 16 is improper in that it is based upon an erroneous finding of fact and failure to establish a *prima facie* case of obviousness, and that these Claims are allowable as presently presented.

10. The rejection of Claims 17 and 18 under 35 U.S.C. 103(a) as unpatentable over McLaughlin et al., as modified by Holmgren, as applied to Claim, further in view of Hey, is respectfully traversed.

For the reasons set forth in paragraph 10, above, the combination of McLaughlin et al. and Holmgren is improper. For the reasons set forth in paragraph 5, above, Hey is insufficient to teach or suggest the type of structure included in Claims 17 and 18. The addition of Hey to an improper combination of references is also improper in that there has been no showing by the Examiner to establish a *prima facie* case of obviousness resulting from the combination. It is not deemed necessary to repeat the reasoning set forth above. It is submitted, however, that this combination of references was only motivated after viewing Applicants' disclosure; and, accordingly, is an improper hindsight attempt to assemble patent references on a piecemeal basis that may at a superficial level appear to teach or suggest the limitations of Claims 17 and 18.

It is submitted that the rejection of Claims 17 and 18 is improper in that it is based upon erroneous finding of fact and failure to establish a *prima facie* case of obviousness, and that these Claims are allowable as presently presented.

11. The indication that Claims 32-37 are allowable is appreciatively acknowledged.

12. The indication that Claims 3-15, 19, 20, 22-27, 29-31, and 39-45 are only objected to as being dependent upon a rejected base claim, and would be allowable if rewritten in independent form to include the limitations of the base claim and intervening claims, is appreciatively acknowledged. It is submitted that the rejected base claims have been shown herein to be allowable, but in the event the Examiner persists in rejecting one or more of the rejected claims, Applicants may submit independent claims in future responses.

CONCLUSION

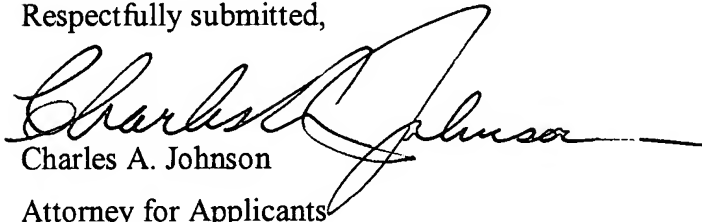
The various stated reasons for objection and rejection have been fully considered and addressed herein. Claims 1-45 remain in the Application, with Claims 32-37 having been indicated as allowable. It has been shown that the Claims as presently presented are

May 18, 2005
Serial No. 10/645,245

allowable. The rejections have been shown to base upon errors of finding of fact and failure to abide by applicable law that resulted in the erroneous rejections. The cited prior art neither teaches nor suggest the various scopes and aspects of Applicants' invention as defined in the Claims. For the reasons stated, Claims 1-45 are allowable and an early notice to that effect is respectfully requested.

If it would be deemed advantageous by the Examiner to discuss any question, or to seek clarifications or understandings that would lead to disposition of this Application or clarification of the issues, the Examiner is invited to call the undersigned representative of Applicants at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charles A. Johnson", with a long horizontal flourish extending to the right.

Charles A. Johnson

Attorney for Applicants

Reg. No. 20,852

1448 90th Avenue
Amery, WI 54001

(651) 635-7702